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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,343	12/28/2001	Dennis McDevitt	9417.17584-CIP	8332

7590

03/03/2004

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EXAMINER

ROBERT, EDUARDO C

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 03/03/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,343

Applicant(s)

MCDEVITT ET AL.

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 and 9 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The Declaration filed on April 16, 2002 states that it is for a continuation-in part (CIP) (see page 1) and that it is claiming benefit of an earlier application under 35 USC 120 using ***provisional application 60/332,170*** having a filing date of September 11, 2001 (see “Added page to combined declaration”, page 1). It is noted that Applicants can not claim benefit of an earlier application under 35 USC 120 with a provisional application, however, they can do it under 35 USC 119(e) (see MPEP 201.11). Moreover, a continuation-in-part application **must** claim the benefit of a prior **non-provisional application** under 35 USC 120 or 365(c) (see MPEP 201.08). Also, an application claiming the benefit of a provisional application under 35 USC 119(e) should not be called a “continuation-in-part” of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, ***not*** a continuation, division, or continuation-in-part of the provisional application (see MPEP 201.08).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1, 2, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (U.S. Patent 5,108,446).

Wagner et al. disclose an implant comprising a base 1 including at least one stem 3 capable of engaging one void created in a bone structure. The stem 3 having an exterior peripherally surrounding an interior lumen. The implant also has a pin 7 that fits into the interior lumen and expands the exterior of the stem 3 (see Figure 3). The implant also has a cap 2 from which the pin 7 depends, wherein fitting the pin 7 into the interior lumen of the stem couples the cap to the base. The cap has a bearing surface and the pin 7 depends from the cap from a surface that faces away from the bearing surface (see Figure 3). The arrangement of the pin 7 is complementary to the arrangement of the stems and alignment of the pin with the stem aligns the base with the cap (see Figure 3). The cap and base include nesting surfaces that rest together when the base is coupled to the cap (see Figure 3). The stem is adapted to expand within the bone to compresses surrounding bone structure (see Figure 3). Wagner et al. disclose the claimed invention except for the base having a plurality of stems and complementary plurality of pins. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the implant of Wagner et al. having a plurality of stems and pins, since it has

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been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Response to Arguments

Applicant's arguments filed on December 12, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that the rejection under 35 U.S.C. 103 does not disclose an implant in which alignment of a plurality of pins depending from a cap and complementary stems included on a base aligns the base with the cap to permit engagement with the lumens of the stems, it is noted that Wagner et al. clearly disclose that alignment of the pin 7 depending from the cap 2 with complementary stem 3 at the base aligns the base with the cap to permit engagement of the pin with the interior lumen of the stem, and the combination clearly states that Wagner et al. disclose the claim invention except for the pin 7 being a plurality of pins and the complementary stem 3 being a plurality of complementary of stems (see 103 rejection above) and that to make the pin and complementary stem as plural of pins and stems would have been obvious to one having ordinary skill in the art at the time the invention was made, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Moreover, applicant has not provide any convincing showing that this is nothing more than a mere duplication of the essential working parts of the device as asserted by the examiner. Applicant has not provided any showing that such limitations are "critical". In re Cole, 140 USPQ 230 (CCPA 1964); In re Kuhle, 188 USPQ 7 (CCPA 1975); In re Davies, 177 USPQ 381 (CCPA 1973). Mere arguments

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by counsel cannot take the place of evidence. In re Cole, 236 F.2d 769, 773, 140 USPQ 230, 233 (CCPA 1964); In re Walters, 168 f.2d 79, 80, 77 USPQ 609, 610 (CCPA 1948); et al.

Allowable Subject Matter

Claims 8 and 9 are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

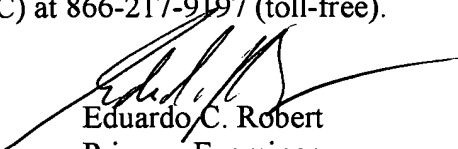
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C.R.